

REMARKS

Claims 15 to 18 are added, and therefore claims 8 to 18 are currently pending in this application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 8 to 14 were rejected under 35 U.S.C. § 102(e) as anticipated by Theisen et al., U.S. Patent No. 7,469,924.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

It is respectfully submitted that the present rejections should be withdrawn for at least the following reasons.

The Theisen reference, U.S. Patent No. 7,469,924, was issued on December 30, 2008 and published as U.S. Patent Application Publication No. 2006/0097496 on May 11, 2006, both of which dates are after the March 19, 2004 German priority date of the present application. United States Patent No. 7,469,924 is the national stage of PCT International Patent Application Publication No. PCT/DE2003/01772, which was published on April 15, 2004 as WO 2004/030998 in German. Since U.S. Patent No. 7,469,924 was not issued

before the priority date of the present application and is a U.S. patent based on an international application filed on or after November 29, 2000, where the international application was not published in English, U.S. Patent No. 7,469,924 does not constitute prior art against the present application.

Furthermore, since U.S. Patent Application Publication No. 2006/0097496 was not published before the priority date of the present application and is a U.S. patent application publication of an international application filed on or after November 29, 2000, where the international application was not published in English, U.S. Patent Application Publication No. 2006/0097496 also does not constitute prior art against the present application. Also, PCT International Patent Application Publication No. PCT/DE2003/01772 is also not prior art with respect to the present application because it was published as WO 2004/030998 on April 15, 2004, which date is also after the March 19, 2004 German priority date of the present application. A certified translation of the German priority application (DE 10 2004 013 598.3) accompanies this response.

Accordingly, claims 8 to 14 are allowable.

New claims 15 to 18 do not add any new matter and are supported by the present application, including the specification. Claims 15 to 18 depend from claim 8, and are therefore allowable for the same reasons.

Accordingly, claims 8 to 18 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of pending claims 8 to 18 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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